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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,644	11/01/2001	Jean-Louis Bessereau	1321.2.28.1	7271
21552	7590	02/25/2004	EXAMINER	
MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101			SHUKLA, RAM R	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SA-11

# Office Action Summary

Application No.

09/980,644

Applicant(s)

BESSEREAU ET AL.

Examiner

Ram R. Shukla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12-4-03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 21-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-1-02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's election of the invention of group II, claims 20-46 in Paper filed 12-4-03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-19 and 47-56 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed 12-4-03.

3. Claims 20-46 drawn to a method of transposon-mediated mutagenesis in a *C. elegans* genome by introducing a transgene comprising a transposase operably linked to a promoter and a 3' untranslated region of a *C. elegans* gene are under consideration.

4. If applicant desires priority under 35 U.S.C. 119 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior

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application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 20-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claimed invention comprises the 3' untranslated region of any gene that is expressed in germ line in the *C.elegans* and any inducible promoter.

When the claims are analyzed in light of the specification, instant invention encompasses the 3' UTR of any gene expressed in germ line of *C.elegans*, any regulable expression control element and any inducible promoter. However, the specification discloses only discloses 3' UTR of *glh-2* gene. In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. In the instant case, *glh-2* gene is the only species whose complete structure is disclosed. The specification does not provide any disclosure as to what would have been the complete structure of the 3' UTR of a representative number of genes that are expressed in germ line, what would have been the complete structure of a representative number of any regulable expression control elements and what would have been the structure of a representative number of species of the inducible promoters. Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics (i.e. other than nucleotide sequence), specific features and functional attributes that would distinguish different members of the claimed genus. In the instant case, the only other identifying characteristic is that the gene is expressed in germ line which cannot be an identifying characteristic since all the genes will have that characteristic. No identifying characteristics of the inducible promoters or regulable expression control elements are disclosed.

Applicants' attention is directed to the decision in *In re Shokal*, 113 USPQ 283 (CCPA 1957) wherein is stated:

It appears to be well settled that a single species can rarely, if ever, afford sufficient support for a generic claim. *In re Soll*, 25 C.C.P.A. (Patents) 1309, 97 F.2d 623, 38 USPQ 189; *In re Wahlforss et al.*, 28 C.C.P.A. (Patents) 867, 117 F.2d 270, 48 USPQ 397. The decisions do not however fix any definite number of species which will establish completion of a generic invention and it seems evident therefrom that such number will vary, depending on the circumstances of particular cases. Thus, in the case of small

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genus such as the halogens, consisting of four species, a reduction to practice of three, or perhaps even two, might serve to complete the generic invention, while in the case of a genus comprising hundreds of species, a considerably larger number of reductions to practice would probably be necessary.

In conclusion, this limited information is not deemed sufficient to reasonably convey to one skilled in the art that Applicant is in possession of the genes that are expressed in the germ line of *C.elegans*, at the time the application was filed. Thus it is concluded that the written description requirement is not satisfied for the claimed genus.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 20-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plasterk et al (US 6,051,430, 4-18-00) in view of Vos et al (Genes and Development 10:755-761, 1996), Van Leunen et al<sup>1</sup> (Cell 79:293-301, 1994), Van Leunen et al<sup>2</sup> (The EMBO Journal 12:2513-2520, 1993), Hackett et al (US 6,489,458 B2, 12-3-2002, filing date 3-11-1998) and Gallegos et al (The EMBO Journal 17:6337-6347, 1998).

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Plasterk et al teaches methods for integrating desired nucleic acid into other nucleic acid material including the genome of *C.elegans* using the transposon and transposase of the Tc/Mariner family (see the entire document). Specifically the art teaches expression vector for transposons and transposase which comprise specific elements for specific purposes, such as presence of regulatory elements in the vector, presence of inducible promoters for switching on or off of the integration into the genome, introduction of the transposase vector in *C.elegans* (see columns 3-6). Vos et al teaches transposition by transposase Tc1 by expressing Tc1 under the control of heat shock promoter (see the methods section on page 760). van Luenen et al teaches transposition by Tc3 in *C.elegans* by expressing Tc3 transposase under the control of heat shock promoter (see the methods sections). Van Luenen et al<sup>2</sup> also discusses Tc3A transposon. While these arts teach transposase expression vector comprising a heat shock promoter driving the expression of transposase gene, none of these articles teaches a vector that comprises a 3' untranslated region of a gene that is expressed in germ line.

Gallegos et al teaches repression of 3' UTR of *fem-3*, a sex-determining gene. The art also teaches expression vectors that have intron, 5' UTR and 3'UTR expression of a gene of interest in germ line and its control by the 3' UTR of *fem-3*. The 3' UTR of *fem-3* gene is also responsive to heat shock (see the abstract and the materials and methods section).

Hackett et al teaches DNA based transposon system for the introduction of nucleic acid into DNA of a cell (see the entire document). The art also reviews the state of the art and indicates different inducible transcriptional control systems such as tetracycline control system (see page 4, references by Gossen et al, Tet expression systems and Cells by Clontech etc.).

At the time of the invention, it would have been obvious to an artisan of skill to modify the vector of Plasterk et al or Vos et al or Van Luenen et al<sup>2 or 1</sup> by adding the 3' untranslated region of *fem-3* and using different inducible transcriptional control system such as tet-based system with a reasonable expectation of success. An artisan would have been motivated to modify the vector because this would

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have allowed to integrate the vector in the germ line and being heat shock responsive it would provide double control.

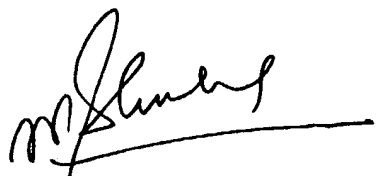
9. No claim is allowed.

10. Applicants' publication (Bessereau et al. Nature 413:70-74, 2001) which describes mobilization of Mos1 transposon and transposase in C.elegans germ line using a vector comprising heat shock promoter and glh-2 3' UTR is made of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (571) 272-0735 . The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571) 272-0734. The fax phone number for TC 1600 is (703) 703-872-9306. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (571) 272-0548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ram R. Shukla, Ph.D.  
Primary Examiner  
Art Unit 1632



**RAM R. SHUKLA, PH.D.**  
**PRIMARY EXAMINER**